

## **Remarks**

### **Claim Status**

By this amendment, claims 1 and 3 are amended, claim 2 is canceled without prejudice or disclaimer, and new claims 30-34 are added by this response. Claims 1, 3-5 and 26-34 are pending.

### **Drawings**

The Office Action objected to the drawings because reference character "167" is not mentioned in the specification. By this amendment, the reference character "167" is deleted from the drawings.

### **Claim Rejections**

#### **Rejections of Claims 1-3**

The Office Action rejected claims 1 and 2 as being anticipated by U.S. Patent No. 6,823,869 to Raje et al. and rejected claim 3 as being unpatentable over Raje et al. in view of U.S. Patent Application Publication Pub. No. 2002/0100479 to Scarberry et al.

Amended claim 1 is not anticipated by Raje et al. Claim 1 has been amended to recite a retaining ring permanently secured to the shell inside a side wall of the shell. Referring to Figs. A9A, F44, F67, and F68 of Raje et al., the retaining ring 510 (Figs. F44, F67, and F68) is releasably connected to the shell 40 by clips 512 (Figs. F44, F67, and F68). As such, amended claim 1 is not anticipated by Raje et al.

Amended claim 1 is also not obvious in view of Raje et al. and Scarberry et al. In the rejection of claim 3, the Office Action asserts that it would have been obvious to one having ordinary skill in the art to use screws or tacks to more securely connect the retaining ring to the shell. Applicant respectfully points out that it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). One having ordinary skill in the art would not permanently secure the retaining ring 510 to the shell 40 of Raje et al., because Raje et al. teaches away from permanently securing the ring 510 to the shell 40. Raje et al. states:

An additional problem in the art has been that the cushion of a mask assembly is not easily attachable, removable and/or re-

attachable to/from the shell. It is desirable for a user to be able to easily assemble, disassemble and/or reassemble the cushion and shell assembly for periodic cleaning and other miscellaneous purposes.

Raje et al., col. 3, ll. 53-58.

Raje et al. further states:

In many known masks, the cushion is provided with a lip around its shell side periphery which engages a flange running around a cushion side periphery of the shell. The cushion lip can be either single sided, wherein it engages an outer edge or an inner edge of the shell flange, or it can be double sided, wherein it engages both sides of the shell flange. While such a mechanism is effective in retaining the cushion to the shell, it can require finger strength and dexterity to assemble and disassemble the cushion/shell assembly. Since the shell and cushion should preferably be disassembled periodically for cleaning, it is desirable to provide a connection mechanism between the cushion and the mask that is easier to assemble and disassemble. This is especially important where the user may lack finger strength and/or dexterity due to injury, impairment or advanced age.

Raje et al., col. 25, ll. 11-28.

One having ordinary skill in the art would have recognized that permanently securing the retaining ring 510 to the shell 40 of Raje et al., would make it more difficult to assemble and disassemble the cushion with the shell. As a result, one having ordinary skill in the art would not have permanently secured the retaining ring 510 to the shell 40 of Raje et al.

Applicant also points out that if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The intended purpose of the retaining ring 510 of Raje et al. is to easily attach to and detach from the shell 40 to thereby easily assemble and disassemble the cushion 30 with the shell 40. Raje et al. states:

To disassemble the cushion 30 from the shell 40, the user need only press the two clips 512 toward one another until they are no longer engaging the surface 52 such that the clips 512 can pass back through the slots 508. In this regard, it is preferable to have only two clips 512 positioned across from one another with a sufficiently small distance therebetween such that the user can grasp both clips 512 between the thumb and forefinger of one hand so that disassembly is a one-handed procedure. In this manner, the

cushion/retaining ring assembly can easily be disassembled from the shell 40 for cleaning or other purposes.

Raje et al., col. 26, ll. 29-42.

Permanently securing the retaining ring 510 to the shell 40 would render the retaining ring 510 unsatisfactory for its intended purpose of attaching and detaching from the shell 40.

Applicant respectfully submits that claim 1 is not anticipated by Raje et al. or obvious in view of Raje et al. in view of Scarberry et al.

Amended claim 3 depends from claim 1 and is allowable for at least the reasons claim 1 is allowable.

New claim 30 depends from claim 3 and is allowable for at least the reasons claim 1 is allowable.

New independent claim 33 recites a retaining ring permanently secured to a shell inside said side wall by sleeves that are heat staked on posts. At least this feature of new claim 34 is not disclosed or suggested by Raje et al., Scarberry et al., or the combined teachings of Raje et al. and Scarberry et al. Claim 33 is in condition for allowance.

#### Rejections of Claims 4-5 and 26-29

The Office Action rejected claims 4-5 and 26-29 as being unpatentable over U.S. Patent No. 7,007,696 to Palkon et al. in view of U.S. Patent No. 2,133,699 to Heidbrink. Applicant respectfully submits that claim 4 is not obvious in view of the combined teachings of Palkon et al. and Heidbrink, because claim 4 recites features that are not disclosed or suggested by the combined teachings of Palkon et al. and Heidbrink. For example, claim 4 recites "said inner wall of said cushion being discontinuous in a nasal bridge region of said cushion." As the Office Action points out, Palkon lacks the teaching that the inner wall of the cushion is discontinuous.

The Office Action asserts that Heidbrink teaches a mask with a discontinuous inner membrane at the nasal bridge region. Applicant respectfully presents Fig. 2 from Heidbrink here to show that this assertion is not correct. Fig. 2 illustrates that the inner layer or flap 19 of Heidbrink is clearly present in the nasal bridge region and not discontinuous.

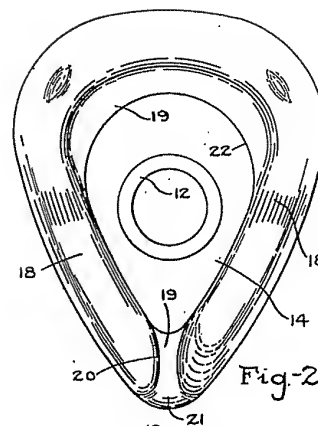
Claim 4 is patentable over the combined teachings of Palkon and Heidbrink.

Claims 5 and 26-29 depend from claim 4 and are allowable for at least the reasons claim 4 is allowable.

New claim 31 depends from claim 4 and further recites that the inner wall of the cushion is not present in said nasal bridge region of said cushion. This feature is not disclosed or suggested by the combined teachings of Palkon and Heidbrink.

New claim 32 depends from claim 4 and further recites that a gap is formed between two ends of the inner wall of the cushion in the nasal bridge region of said cushion. This feature is not disclosed or suggested by the combined teachings of Palkon and Heidbrink.

New independent claim 34 recites an inner wall of a cushion having spaced apart ends that form a gap at a nasal bridge region of said cushion. At least this feature of new claim 34 is not disclosed or suggested by the combined teachings of Palkon and Heidbrink. Claim 34 is in condition for allowance.

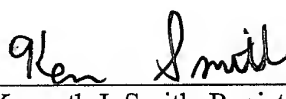


#### Prosecution Independent from Related Applications

Since the present application is a continuation of one or more previously filed applications and/or patents and specifically seeks claims of differing scope than in the parent application(s) and/or patents(s), Applicant presumes that the examination of the present claims was and is being conducted by giving the claims their broadest reasonable interpretation and without reliance on or incorporation of any arguments or amendments or other prosecution history related to the claims of the parent application(s) and/or patent(s). Any such arguments or amendments or other prosecution history that may have occurred in the parent application(s)

and/or patent(s) are not intended to limit the scope of the present claims or to affect their interpretation or construction.

Applicant requests reconsideration and allowance of this application in view of the foregoing amendments, remarks, and all prior art that is of record in the present application.

Date: <u>Nov. 5, 2008</u>	Respectfully submitted,   Kenneth J. Smith, Registration No. 45,115 Customer No. 24024 Telephone: 216-622-8674
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